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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/540,326  
Filing Date: January 25, 2006  
Appellant(s): MADDOX ET AL.

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Donald G. Bauer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 18, 2010 appealing from the Office action mailed January 22, 2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 15-31 and 33 are pending.

Claims 15-23, 27, 28 and 33 are rejected.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner.

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

2004/0123311	Farrar et al.	6-2004
6,880,372	Kim	4-2005
6,084,498	Stelter et al.	7-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-20 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication Number 2004/0123311 to Farrar et al.

Farrar et al. disclose an apparatus (25) for releasing a magnetic security device (8A) in an article (1-3), the apparatus having a first portion (portion contiguous with 25A) for locating the article in a first direction and a second portion (portion contiguous with 25B) for locating the article in a second direction substantially perpendicular to the first direction, the first and second portions define a receptacle (are defined between the first and second portions; figure 6) configured and adapted to receive the article so as to physically restrain the article in the first and second directions as it is brought into contact with the first and second portions, while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions (the first and second portions providing alignment of an article in the vertical and lateral directions while allowing the article to be unrestrained in the axial direction; figure 6), the receptacle being configured and adapted to receive first and second surfaces of the article that are wider than the apparatus, such that the article when received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in the fourth direction opposite the third direction (the receptacle is comprised of two orthogonal portions which allow free movement in all but the first and second directions), and at least one of the first and second portions including magnetic release means (paragraph 104) arranged to assist in locating the article, when the article is initially misaligned into alignment in the third direction by magnetic attraction of the security device as the article is brought into contact with the at least one of the first and second portions (paragraph 104), the magnetic release means being arranged to provide a first magnetic force (paragraph 106) in a first direction and a second magnetic force

(paragraph 106) in the second direction for releasing the magnetic security device (paragraph 106) from the article, as in claim 15.

Farrar et al. also disclose the first portion defines a first plane (plane defined by the first portion) and the second portion defines a second plane (plane defined by the second portion) substantially perpendicular to the first plane (figure 6), as in claim 17, in which the first and second planes define a receptacle (are defined between the first and second portions; figure 6) having a substantially L-shaped cross-section (figure 6), as in claim 18, as well as the first and second portions respectively comprise a base portion (25A) and a top portion (25B) upstanding therefrom, as in claim 19, wherein the first and second portions are connected together by means of at least one mutually engageable projection and recess (the corner defining the transition between the bottom surface and the rear surface), as in claim 20, and a method of releasing a magnetic security device comprising the steps of providing an apparatus as in claim 15 (25) and presenting an article (1-3) with a magnetic security device (8A) thereto to release the magnetic security device therefrom (paragraphs 104-109), as in claim 28.

Farrar et al. additionally disclose an apparatus (25) for releasing a magnetic security device (8A) in an article (1-3), the apparatus having a first portion (portion contiguous with 25A) for locating the article in a first direction and a second portion (portion contiguous with 25B) for locating the article in a second direction substantially perpendicular to the first direction, wherein the first and second portions define an L-shaped receptacle (figure 6) configured and adapted to restrain the article in the first and second directions as it is brought into contact with the first and second portions (the first and second portions providing alignment of an article in the vertical

and lateral directions while allowing the article to be unrestrained in the axial direction; figure 6), while leaving the article unrestrained in at least a third direction (the receptacle is comprised of two orthogonal portions which allow free movement in all but the first and second directions) substantially perpendicular to the first and second directions, the L-shaped receptacle being capable of receiving articles of a wide range of shapes and sizes (capable of receiving any article that can be placed in the receptacle, where the axial length be any of a various length) having a security device installed adjacent two substantially perpendicular sides thereof (figure 6), the receptacle being configured and adapted to receive an article having first and second surfaces that are wider in the third direction than the apparatus (figure 6), and at least one of the first and second portions including magnetic release means (paragraph 104) arranged to provide a first magnetic force (paragraph 106) in the first direction and a second magnetic force (paragraph 106) in the second direction for releasing the magnetic security device (paragraph 106) from the article, wherein the receptacle is adapted and configured to receive the article such that the size of the surfaces of the article within the receptacle are unrestricted in at least the third direction and a fourth direction opposite the third direction (the receptacle is comprised of two orthogonal portions which allow free movement in all but the first and second directions), as in claim 16.

Farrar et al. also disclose at least one of the first and second portions including magnetic release means (paragraph 104) arranged to assist in locating the article in a third direction substantially perpendicular to the first and second direction by magnetic attraction of the security device as the article is brought into contact with the at least one of the first and second portions so as to align the magnetic security device with the magnetic release means (paragraphs 104-106), as in claim 27.

Farrar et al. further disclose an apparatus (25) for releasing a magnetic security device (8A) in an article (1-3), the apparatus comprising a first portion (portion contiguous with 25A) for locating the article in a first direction (direction coaxial with 25A) and second portion (portion contiguous with 25B) for locating the article in a second direction (direction coaxial with 25B) substantially perpendicular to the first direction, the first and second portions defining a receptacle (are defined between the first and second portions; figure 6) configured and capable of receiving first and second surfaces of the article such that the first and second surfaces of the article when received in the receptacle may extend beyond the apparatus in a third direction (the receptacle is comprised of two orthogonal portions which allow free movement in all but the first and second directions) that is substantially perpendicular to the first and second directions, and may extend beyond the apparatus in a fourth direction (the receptacle is comprised of two orthogonal portions which allow free movement in all but the first and second directions) opposite the third direction, and magnetic release means (paragraph 104) associated with the receptacle for releasing the magnetic security device in the article, as in claim 33.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrar et al., as applied above, in view of U.S. Patent Number 6,880,372 to Kim.

Farrar et al. disclose the invention substantially as claimed. Farrar et al. discloses the magnetic release means applies a first magnetic force in a first direction and a second magnetic force in a second direction. However, Farrar et al. do not disclose a first and a second magnet causing the magnetic forces. Kim teaches of an apparatus (60) for releasing a magnetic security device (2) in an article (1), the apparatus comprising a first portion (base of element 60 where magnet 62 is disposed) for locating the article in a first direction (direction coaxial with the axis of magnet 62) and a first magnet (62) for applying a first magnetic force and second portion (base of element 60 where magnet 63 is disposed) for locating the article in a second direction (direction coaxial with the axis of magnet 63) substantially perpendicular to the first direction and a second magnet (63) for applying a second magnetic force, the first and second portions defining a receptacle (61) configured and capable of receiving first and second surfaces of the article such that the first and second surfaces of the article extend beyond the apparatus in a third direction (direction coaxial with the axis of magnet 64) that is substantially perpendicular to the first and second directions, in the same field of endeavor for the purpose of establishing a first magnetic force in a first direction and a second magnetic force in a second direction. It would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize a first magnet, as taught by Kim, to apply the first magnetic force, in Farrar et al., and a second magnet to apply the second magnetic force in order to withdraw the magnetic security device from the article at least far enough to prevent re-engagement of the security device with the article.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrar et al. and Kim, as applied above, in view of U.S. Patent Number 6,084,498 to Stelter et al.

Farrar et al. and Kim teach of an apparatus (25) for releasing a magnetic security device (8A) from an article (1-3), the apparatus comprising a first portion (portion contiguous with 25A) for locating the article in a first direction and a second portion (portion contiguous with 25B) for locating the article in a second direction substantially perpendicular to the first direction (figure 6), the first and second portions forming a receptacle (are defined between the first and second portions; figure 6) for receiving the article but physically restraining the article in the first and second directions as it is brought into contact with the first and second portions (restrained by the base and wall), while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions (allowing the article to be moved in an axial direction of the article; figure 9), at least one of the first and second portions including magnetic release means (paragraph 104) arranged to assist in locating an initially misaligned article into alignment in the third direction by magnetic attraction of the security device as the article is brought into contact with the at least one of the first and second portions (column 5, line 59-column 6, line 32), the magnetic release means being arranged to provide a first magnetic force in the first direction (paragraph 106) and a second magnetic force in the second direction (paragraph 106) for releasing a magnetic security device from the article, wherein Kim teaches of a magnetic release means include a first magnet assembly (62) and a second magnet assembly (63). However, Farrar et al. and Kim do not disclose the first or second magnets are comprised of a plurality of magnets.

Stelter et al. teach of a magnetic decoupler (10) for releasing a magnetic security device (figures 5 and 6) consisting of a magnetic release means (11, 12, 13, 14, 15 and 16), Where the magnetic release means includes a central magnet (11 and 16) and a plurality of peripheral magnets (12, 13, 14 and 15) mounted adjacent to the central magnet (figure 3) such that the magnetic axis of each peripheral magnet of the plurality of peripheral magnets are substantially perpendicular to the magnetic axis of the central magnet (column 4, lines 9-48).

Because both Farrar et al., Kim and Stelter et al. teach methods for unlocking magnetic security devices, it would have been obvious to one with ordinary skill in the art to substitute the magnetic assembly, where the assembly consists of a plurality of magnets, in Stelter et al. with the single magnets in Farrar et al. to achieve the predictable result of improving the magnetic strength of the magnetic release means from the orientations of the magnets that increase the axial magnetic field gradient by superposition of the magnetic fields of each individual magnets.

#### **(10) Response to Argument**

In response to the argument that Farrar et al. do not disclose that when an article is received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in a fourth direction opposite the third direction, as well as the Appellant's assertion that "the only thing one can conclude, from a cross-section drawing such as Figure 6, is the local shape of the device at the location of the section. The cross section itself is not sufficient to conclude anything about any other portions of the device, including whether the third and fourth directions are unrestrained." The examiner states that the rejection not only indicated Figure 6 of Farrar et al. as the apparatus, but also paragraphs 104, 106 and 109 from

the Patent Application Publication. Where the paragraphs disclose “in order to release the device 8A from the case, the case is brought up to a magnetic release device 25 which is shaped so as to align a first part 25A adjacent the case in alignment with the spring arm 18 so as to draw the arm 18 out of engagement within the projection 23 and to align a second part 25B with the head 11A of the device so the magnetic pull on the end piece 10 of the metal insert 16 withdraws the device 8A from the case at least far enough to prevent re-engagement of the spring arm 18 with the projection 23. The device 8A can then be withdrawn from the case. The magnetic release device 25 thus applies a first magnetic force in a first direction to release the locking device formed by the spring arm 18 and projection 23 and a second magnetic force in a second direction to withdraw the security device from the case at least far enough to prevent re-engagement of the locking device when it is no longer held in a release position by the first magnetic force. The security device can then be withdrawn from the case manually or the second magnetic force may be used to pull it out of the case. The magnetic release device 25 can be provided adjacent a sales till in a store for use only by sales staff. Once the security device 8A has been withdrawn, the case and the disk held therein can be taken from the store by a customer without triggering an alarm. The security device 8A can then be re-used in another case.” This passage is absent of any recitation of restraining or aligning the case in any direction other than those defined by elements 25A and 25B, leaving one to conclude that it is inherent within the cited passage that the third and fourth directions are not restrained in any manner.

Responding to the Appellant’s assertion that apparatus 25, shown in figure 6, and the apparatus shown in figures 34-36 are the same embodiment, the examiner respectfully disagrees. As clearly shown in the respective figures, the embodiment disclosed in figures 34-36 has

additionally structure and elements, including, but not limited to, a top portion that restrains a case in a vertical direction (as shown in cross-section of figures 36A-C), which is absent in the cross-section of apparatus 25 in figure 6. Accordingly, with the additional structure, one can conclude that the apparatus in figures 34-36 are of a structurally different embodiment than that of apparatus 25 in figure 6. Additionally, the two separate and distinct embodiments are characterized by the use of different reference numerals and cited in completely different sections and paragraphs of the publication. Moreover, Farrar et al. disclose embodiments other than those in the aforementioned figures for releasing a magnetic security device in an article, such as those in figure 8 (element 30), and figures 9A-D (element 40), resulting in multiple embodiments to release a magnetic security device.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Christopher J. Boswell /cb/

Conferees:

Peter M. Cuomo /pmc/

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